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In re Application of
ENOMOTO et al.
Application No. 09/327,167
Filed: June 7, 1999
For: IMAGE FORMING APPARATUS

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed March 15, 2001, to withdraw the holding of abandonment of the above-identified application.

The petition is **DENIED**.

This application was held abandoned for failure to file a proper response to the final Office action mailed on June 23, 2000. A Notice of Abandonment was mailed on March 2, 2001.

Petitioner asserts that the June 23, 2000 Office action failed to identify a reference used in the rejection of the claims and that on December 20, 2000, applicants' representative made a telephone call to the examiner in charge of this application requesting identification of the reference. Petitioner asserts that, in response, the examiner identified the reference as U.S. Patent No. 6,042,917 and indicated that she would restart the period for response to the outstanding Office action and that it was therefore unnecessary for applicant to respond to the June 23, 2000 Office action.

The examiner has been contacted and confirms that she indicated to applicants' representative she would send out a new Office action and restart the time period. However, the examiner indicates that she assumed that she was being notified of the error within the 3-month time period for reply set in the Office action and, after turning in a new Office action to be mailed, was informed that the time period could not be restarted and that the application had become abandoned because the 6-month statutory period had expired. The examiner indicates that she then contacted applicants' representative to inform him that the case was abandoned and that he would need to petition to have the case revived.

The evidence of record indicates that the examiner was not informed of her failure to properly identify the reference during the period for reply set in the June 23, 2000 Office action. As set forth in MPEP § 710.06, "If the error in citation or other defective Office action is called to the attention of the Office after the expiration of the period for reply, the period will not be restarted

and any appropriate extension fee will be required to render a reply timely.” Thus the examiner was without authority to restart the period for reply. Moreover, the examiner was not informed of the matter prior to December 20, 2000, a mere three days prior to expiration of the maximum extendable period under 37 CFR 1.136(a) for reply to the June 23, 2000 Office action. As no request for an extension of time was filed during the statutory period for response, this application became abandoned by operation of law on midnight, September 23, 2000.

It is regretted that the examiner was unable, during the statutory period for reply, to mail an Office letter correcting the error and informing applicant that the time period for reply remains as set forth in the previous Office action. Nevertheless, in the absence of a proper response to the Office action, the application was properly held to be abandoned. Accordingly, the petition to withdraw the holding of abandonment is denied.

Petitioner may wish to consider filing a petition to the Commissioner under 37 CFR 1.137 requesting that the application be revived. See MPEP 711.03(c)(III).

Questions regarding this decision should be directed to Hien H. Phan at (703) 308-7502.



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HP/jc